



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
PATENT EXAMINING OPERATION

Applicant(s): James M. Zavislan et al.

Serial No.: 10/698,294

Confirmation No. 1407

Filed: October 31, 2003

For: CELLULAR SURGERY UTILIZING CONFOCAL MICROSCOPY

Examiner: Smith, Ruth S.

Art Unit: 3737

Atty Docket: ML-0434DIV

RESPONSE TO OFFICE ACTION DATED 11/02/05

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Claims 7-10, 12, and 13 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,760,950 (Maly et al.) "Maly". This rejection is respectfully traversed. Maly's scanning confocal microscope does not provide the Claim 7 step of "treating tissue with the aid of an illumination beam". It is the Examiner's position on page 2 of the Office Action dated November 2, 2005, that Maly "disclose[s] (as seen for example in column 13) that the treatment can involve laser surgery". However, none of Maly's optics shown in FIGS. 2A or 2B are described anywhere in Maly as providing treatment to tissue. Mere statement that Maly's microscope can observe "the effects of laser refractive surgery" at lines 12-13 of column 13, does not express or imply that Maly's microscope can perform laser refractive surgery, as the Examiner appears to contend.

It is well-established patent jurisprudence that a reference to be anticipatory must have an enabling disclosure of the claimed subject matter (see MPEP 2121.01). Such clearly is not the case here in regards to Maly where its optical system 120 (FIG. 2A) is not described, or even

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